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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Tao Shi GAO

Examiner:

C. Melissa Koslow

Serial No: **09/935721**

Group Art Unit: **1755**

Filed : **August 24, 2001**

For : **MAGNETIC WRITING
SCREEN DISPERSION MEDIUM**

RESPONSE TO NOTICE OF NON-COMPLIANCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In the Notice mailed April 14, 2004, the Examiner noted that the claims listed in the second issue should be claims 10 and 11. Also, the Examiner indicated that claim 11 was missing from the Appendix. Applicant re-submits the Appeal Brief, with the correct claims identified in the second issue and claim 11 listed in the Appendix.

The Examiner also stated that the Brief does not present an argument under a separate heading for each issue on appeal. As there are issues identified as A-D, headings have been added to the argument section.

With the re-submission of the Appeal Brief, all issues raised in the Notice of Non-Compliance have been addressed. It is respectfully requested that the Appeal Brief be entered and acted upon.

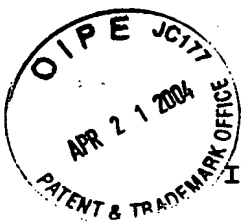
Respectfully submitted,

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Reg. 41,533

April 20, 2004

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Attorney Docket No. A-7432.RNNC/bh



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Tao Shi GAO

Examiner:

C. Melissa Koslow

Serial No: **09/935721**

Group Art Unit: **1742**

Filed : **August 24, 2001**

For : **MAGNETIC WRITING
SCREEN DISPERSION MEDIUM**

APPLICANT'S APPEAL BRIEF
UNDER 35 U.S.C. §1.192

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

(1) REAL PARTY IN INTEREST

The real party in interest is Tsuen Lee Metals & Plastic Toy Co., the Assignee of the present application.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

(3) STATUS OF CLAIMS

Claims 1-6 and 10-15 are pending and appealed.

(4) STATUS OF AMENDMENTS

An Amendment After Final Rejection was filed September 11, 2003 and was not entered.

(5) SUMMARY OF INVENTION

The invention relates to a magnetic dispersion medium used in a magnetic writing screen toy. The bulk of the magnetic

dispersion medium is liquid paraffin. Silica is added to the liquid paraffin, as a thickener and titanium oxide is added as a colorant, both present in the range of 1.5 to 3% by weight. A second colorant, benzo oxazole fluorescent whitener, is also present. Iron powder accounts for 13-20% by weight of the mixture. During use, a magnetic tipped pin attracts the iron powder to the top sheet of the magnetic screen toy, leaving a line of black iron particles visible in the white dispersion medium. The viscosity of the dispersion medium retains the iron particles against the screen.

(6) ISSUES

A. Are claims 1 and 10 properly rejected under 35 USC §112, second paragraph as being indefinite because the term "bulk material" is unclear.

B. Are the claims properly rejected under 35 USC §112, first paragraph because the specification does not reasonably provide enablement for the claims.

C. Are claims 1-6 and 10-14 properly rejected under 35 USC §112, first paragraph as not supported by the specification because the claims do not specify the amount of each component and the composition is not limited to that disclosed in the specification.

(7) GROUPING OF CLAIMS

Claims 1-6 and 10-15 stand or fall together.

(8) ARGUMENTS

A. Are claims 1 and 10 properly rejected under 35 USC §112, second paragraph as being indefinite because the term "bulk material" is unclear.

The Examiner rejects claims 1 and 10 as being indefinite since it is unclear what is meant by bulk material.

The specification states that the bulk of the material is liquid paraffin. In other words, the liquid paraffin is a bulk material for the composition. One of ordinary skill in the art, knows that a medium needs a bulk material, or carrier, as a starting point for a composition in order to hold the other components in suspension and would readily know other substances which could be used as bulk material. The term 'bulk material' is readily understood by one of ordinary skill in the art and is definite.

B. Are the claims properly rejected under 35 USC §112, first paragraph because the specification does not reasonably provide enablement for the claims.

The Examiner maintains two rejections under 35 USC §112, first paragraph because the specification, being enabling for a magnetic dispersion including liquid paraffin, 1.5 to 3 wt% silica, 1.5 to 3 wt% titania, 0.001 to 0.005 wt% benzo oxazole fluorescent whitener and 13 to 20 wt% steel powder containing up to 17 wt% manganese does not provide reasonable enablement for the magnetic dispersion medium in claims 1-6, 12-15 and claims 10 and 11.

Enablement is measured by whether the specification discloses how to make and use the invention to one of ordinary skill in the art. The detailed description of the invention clearly discloses that the bulk of the liquid dispersion medium is liquid paraffin. Therefore, one of ordinary skill in the art knows that liquid paraffin serves as a bulk material. Liquid compositions need a bulk material, or carrier, to hold components in suspension. The magnetic dispersion medium is a well-developed, predictable art, and the materials suitable as a bulk material are well understood and known by one of ordinary skill in the art.

Likewise, the specification states that silica functions as a thickener and iron powder as a magnetic material. One of ordinary skill in the art would be aware of other substances that can be used as thickeners or colorants without effecting the function and performance of the magnetic dispersion

medium. The specification, therefore, discloses the use of two different colorants.

Claims 1 and 12 are limited to the use of titanium dioxide as a first colorant and benzo oxazole fluorescent as a second colorant. One of ordinary skill in the art would readily know what substances can be used for the recited elements of a bulk material, a thickener and a magnetic material. Claim 12, moreover, specifically recites that these materials are liquid paraffin, silica and iron powder, respectively. In claim 10, the same issues appears as one of ordinary skill in the art would readily know what substances can be used for the recited elements of a bulk material, a thickener and a magnetic material.

The specification discloses a magnetic dispersion medium having a bulk material (liquid paraffin), a thickener (silica), and a first and second colorant (titanium dioxide; oxazole fluorescent whitener). The disclosure clearly enables one of ordinary skill in the art to make a dispersion having the subject matter of the claims.

C. Are claims 1-6 and 10-14 properly rejected under 35 USC §112, first paragraph as not supported by the specification because the claims do not specify the amount of each component and the composition is not limited to that disclosed in the specification.

The Examiner maintains a rejection as stating the claims 1-6 and 10-14 and claims 10-11 are not described in the specification so as to reasonably convey to one of ordinary skill in the art that the inventor had possession of the claimed invention. Specifically, the Examiner states that the disclosure does not support claimed materials where the amounts are not given and the composition is not limited to that disclosed in the specification.

The Examiner states that "applicant admits that the claims are broader than the enabled dispersion medium in lines 13-14 in the second paragraph of their arguments on page 3 of the response." This statement is not true as the applicant admits

the claims are broader than the disclosed composition, not the enabled composition.

The weakness of the two rejections maintained under 35 USC §112, first paragraph, are illuminated by reference to the Amendment After Final Rejection filed September 11, 2003, wherein description was added to the summary of the invention without adding new matter. The Examiner stated that such additions overcame the rejections under 35 USC §112, first paragraph, but denied entry because it was unclear as to what other compounds besides liquid paraffin could be both material.

C. Are claims 1-6 and 10-14 properly rejected under 35 USC §112, first paragraph as not supported by the specification because the claims do not specify the amount of each component and the composition is not limited to that disclosed in the specification?

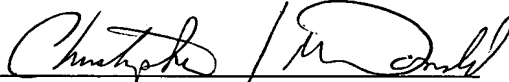
While the specification notes the percent of each component in the composition, therefore disclosing the preferred embodiment and fulfilling the best mode requirement, there is no rationale for limiting applicant to the exact composition disclosed. Claims are always broader than the exact composition, with specifics regarding the composition of the subject of dependent claims. By definition, an independent claim, having dependent claims, is broader than the exact disclosed composition. There is no rationale for limiting the applicant to the exact amounts disclosed in the specification.

Referring to other prior patents disclosing and claiming magnetic dispersion mediums, it is seen that the claims are not limited to the exact percentage of each composition nor the particular type of each component, such as the exact bulk material, needed in order to obtain patent protection for the composition. Specifically, reference is made to U.S. Patent 4,143,472 (Murata et al) and U.S. Patent 5,419,498 (Ikeda et al).

CONCLUSION

The claims are allowable over the prior art and it is respectfully requested that all rejections made by the Examiner be overturned and the application allowed to proceed toward issuance.

Respectfully submitted,


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March 15, 2004

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Attorney Docket No. A-7432.AB/cat

Appendix of Claims

1. A magnetic dispersion medium, comprising:
 - a bulk material,
 - a first colorant, wherein said first colorant is titanium dioxide,
 - a second colorant, wherein said second colorant is benzo oxazole fluorescent whitener,
 - a thickener, and
 - a magnetic material.
2. The magnetic dispersion material of claim 1, wherein said bulk material is liquid paraffin.
3. The magnetic dispersion material of claim 1, wherein said thickener is silica.
4. The magnetic dispersion material of claim 1, wherein said magnetic material is iron powder.
5. The magnetic dispersion material of claim 4, wherein said iron powder contains up to 17 percent manganese.
6. The magnetic dispersion material of claim 4, wherein said iron powder has particles less than 100 microns in diameter.
7. Cancelled
8. Cancelled
9. Cancelled
10. A magnetic dispersion medium, comprising:
 - a bulk material,
 - a colorant, said colorant being benzo oxazole fluorescent whitener,
 - a thickener, and
 - a magnetic material.

11. The magnetic dispersion medium of claim 10, wherein said bulk material is liquid paraffin, said thickener is silica, and said magnetic material is iron powder.
12. A magnetic dispersion medium, comprising:
liquid paraffin as a bulk material,
silica for thickening,
benzo oxazole fluorescent whitener, as a first colorant,
titanium dioxide as a second colorant, and
iron powder.
13. The magnetic dispersion material of claim 12, wherein said benzo oxazole fluorescent whitener is .005% by weight.
14. The magnetic material of claim 12, wherein said titanium dioxide is present in the amount of 1.5% to 3% by weight.
15. The magnetic material of claim 12, wherein said silica is present in the amount of 1.5% to 3% by weight.